

REMARKS

I. Status of the Application

Claims 1-21 were pending in this application, prior to entry of the above amendments. In the December 1, 2006 Office action, the Examiner rejected claims 1-11 and 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,966,010 to Loy et al. (hereinafter, “Loy”) in view of U.S. Patent No. 5,933,004 to Jackson et al. (hereinafter “Jackson”).

In this response, Applicant has cancelled claims 12-20, has traversed the examiner’s rejection of claims 1-11 and 21 and has added new claims 22-28. Applicant respectfully requests reconsideration of pending claims 1-11 and 21 and new claims 22-28, in view of the foregoing amendments and the following remarks.

II. Independent Claims 1 and 21

In the December 1, 2006 Office action, the Examiner rejected claims 1 and 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Loy in view of Jackson. Applicant respectfully submits that the rejection of claims 1 and 21 Under 35 U.S.C. § 103(a) as obvious over Loy in view of Jackson should be withdrawn, as the examiner has failed to make a prima facie case of obviousness under MPEP § 2143.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

success. Finally, all claim limitations must be taught or suggested by the prior art. As set forth below, the examiner has failed to meet these criteria.

A. There Must Be Some Suggestion or Motivation To Modify the References

In order to establish a prima facie case of obviousness, there must be some teaching, suggestion or motivation for modifying or combining the references found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP § 2143.01. “There are three possible sources for a motivation to combine references: the nature of the problems to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.”

Id., citing *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

In the present case, the source of the examiner’s motivation to combine references appears to be the knowledge of persons of ordinary skill in the art. Specifically, in the December 1, 2006 Office Action, the examiner stated that, “it would have been obvious to one of ordinary skill in the art at the time of the invention to have constructed the apparatus of Loy ... of flat metal as shown by Jackson.” (See page 4 of the December 1, 2006 Office Action). Then the examiner set forth the following rationale for combining Loy and Jackson: “one of ordinary skill in the art would realize that so doing would decrease manufacturing expense of the apparatus of Loy.” (See page 4 of the December 1, 2006 Office Action).

Even for relatively simple inventive concepts, there must be some evidence or finding “as to the specific understanding or principle within the knowledge of the skilled artisan” that would have provided the motivation to combine references. See *In re*

Kotzab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); also see MPEP 2143.01 citing In re Kotzab. In the present case, the examiner has provided no evidence whatsoever of what one of ordinary skill in the electricity meter art might have known at the time of the invention. Furthermore, the examiner has cited no references suggesting that the coil arrangement of Jackson would be any less expensive to produce than the coil arrangement of Loy. Why is the coil arrangement of Loy any more difficult to produce than that of Jackson? The coil arrangement of Loy involves the attachment of uniform blade portions to middle portions having a uniform cross-section. Jackson on the other hand discloses a flat metal arrangement with non-uniform cross-sectional areas, which is significantly more complex than that of Loy. What convinces the examiner that the manufacturing process for Jackson would be any less expensive than that of Loy? It is respectfully submitted that the examiner has provided no evidence to support his assumption.

In the present case, no documentary evidence has been provided, no implicit disclosure in any reference has been provided, and no official notice has been taken of any facts outside of the record. Instead, the examiner has only provided his own personal opinion of what one in the art might have known at the time of the invention. Applicant respectfully submits that such personal speculation by the examiner, without any more evidence, is insufficient to satisfy the examiner's obligation to establish a motivation to combine references. Absent a clear analysis with supporting rationale for combining references, the Examiner's conclusion that one of ordinary skill in the art would have found it obvious to combine the references is merely impermissible "hindsight." See In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998). Accordingly, for at least this reason, the

Examiner has failed to make a prima facie case of obviousness, and the examiner's rejection of claims 1 and 21 under 35 U.S.C. § 103 should be reversed.

B. There Must Be a Reasonable Expectation of Success

In going from the prior art to the claimed invention, one cannot base obviousness upon what a person skilled in the art might try or might find "obvious to try" but rather must consider what the prior art would have led a person skilled in the art to actually do. See *In re Tomlinson*, 150 USPQ 623 (CCPA 1966). Accordingly, to avoid the "obvious to try" allegation when making a prima facie of obviousness, the examiner must establish the existence of a reasonable expectation of success. MPEP § 2143.02. Such a reasonable expectation of success may be derived from the teachings of the prior art. See, e.g., *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the present case, the examiner has not cited any evidence to suggest a reasonable expectation of success. Instead, in the Final Office Action, the examiner merely provides the conclusory suggestion that combining Loy and Jackson would "decrease manufacturing expense of the apparatus of Loy." However, as discussed previously, there is no suggestion in the art that the arrangement of Jackson would provide any decrease in manufacturing expenses over that of Loy. Accordingly, the examiner has provided no evidence of any reasonable expectation of success for the proposed combination of Jackson and Loy. Without evidence of a reasonable expectation of success, the proposed combination by the examiner is no more than an impermissible "obvious to try" argument. Accordingly, it is respectfully submitted that the examiner has not made a prima facie case of obviousness, as the examiner has not shown a

reasonable expectation of success for the combination of Loy and Jackson, and the examiner's rejection of claims 1 and 21 under 35 U.S.C. § 103 should be reversed.

III. Dependent Claims 2-11 and 22-28

In the December 1, 2006 Office action, the examiner rejected dependent claims 2-11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Loy in view of Jackson. Dependent claims 2-11 depend from and incorporate all the limitations of claim 1. As set forth above, the rejection of claim 1 should be withdrawn. Accordingly, it is respectfully submitted that dependent claims 2-11 are allowable for at least the same reasons the independent claim 1 is allowable, and the examiner's rejection of dependent claims 2-11 under 35 U.S.C. § 103(a) should be withdrawn.

New dependent claims 22-28 also depend from and incorporate all of the limitations of one of independent claims 1 or 21. As set forth above, applicant respectfully submits that claims 1 and 21 are allowable. Accordingly, new dependent claims 22-28 are allowable for at least the same reasons, as well as additional reasons not discussed herein.

In addition to the above, new dependent claims 22-28 are also allowable for additional reasons, as the prior art does not disclose all the limitations of new claims 22-28. For example, with respect to new claim 22, the prior art does not disclose a “measurement contact element” comprising a “blade contact portion including a flexible member biased toward and disposed against the middle portion” of the coil. Another example of a limitation not disclosed by the prior art is a “measurement contact element”

comprising a “circuit board contact portion configured to electrically connect to a circuit board connection.”

For at least the reasons discussed above, dependent claims 2-11 and 22-28 are allowable. Accordingly, it is respectfully submitted that the examiner’s rejection of claims 2-11 under 35 U.S.C. § 103(a) should be withdrawn, and new dependent claims 22-28 should be allowed.

IV. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application is, therefore, respectfully requested.

Applicant has added new claims 22-28, but has also cancelled claims 12-20. Accordingly, applicant believes that no additional fee is required for new claims 22-28. In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,



Russell E. Fowler II
Attorney Registration No. 43,615

Please address correspondence to:

Russell E. Fowler II
Maginot Moore & Beck
Bank One Center Tower
111 Monument Circle, Suite 3000
Indianapolis, Indiana 46204-5115

Telephone: (317) 638-2922
Facsimile: (317) 638-2139
Email: refowler@makinot.com